

Application No. 10/768,414  
Amendment dated 02/04/2005 responding to Office Action dated 11/04/2004

## REMARKS

These remarks address the Examiner's comments made in the Office Action mailed 11/04/2004.

### Objection to Drawings

The office action objects to the drawings under 37 CFR 1.83(a) as failing to show claimed features.

Claim 6 recites "second set of distance marks functionally identifying positions relative to the perpendicular portion of the end piece". This is illustrated in FIG. 9. Claim 6 depends from claim 4 which depends from claim 1. The combined elements of claim 6 are shown in FIG. 9 as follows: housing 102, tape 104 with a distal end (away from the housing), inside measure distance indicators 114 and corresponding distance marks 110, end piece 106 with a portion (visible but not numbered in FIG. 9, but numbered 28 in FIGS. 2 and 5), and a second set of distance marks 108. As is clearly seen in the Detail view 9A, the second distance marks 108 are offset from the first distance marks 110 by a distance which is explained in the specification as "Because the end piece is rigidly mounted to the tape, the outside and inside distance marks will be offset slightly, beyond any offset which accounts for the size of the housing. This extra offset accounts for the thickness of the end piece. ... The thickness and mounting fashion of the end piece dictate finer positioning requirements. In the example shown, the end piece is rigidly mounted and has a thickness of 0.03125 inch. Therefore, the inside distance marks are moved 0.03125 inch more proximal, closer to the housing. This causes the distance mark 110-4 to move from a position even with the mark 104-X to the position at which it is shown in the drawing."

Claim 11 recites "the inside measurement distance marks being offset along the tape from the outside measurement distance marks by a distance corresponding to a thickness of the perpendicular portion of the end piece". This is illustrated in FIG. 9 as explained above regarding claim 6.

Application No. 10/768,414  
Amendment dated 02/04/2005 responding to Office Action dated 11/04/2004

**Rejection over Bouchard**

Claims 1-4, 6-7, and 9-10 were rejected under 35 USC 102(b) as anticipated by US Patent No. 2,240,753 to Bouchard et al.

Claim 1 as amended recites the following structure which is not taught by Bouchard:

exactly one tape (Bouchard has two tapes extending in opposite directions from the housing,

a first set of distance marks functionally identifying positions relative to the distal end (Bouchard has distance marks which identify positions relative to two distal ends; his marks are half-scale), and

a set of inside measure distance indicators each for indicating a distance from the distal end of the tape to a corresponding distance mark plus the longitudinal exterior dimension of the housing (Bouchard's distance indicators each indicate twice a distance from the distal end of one tape to a corresponding distance mark plus half the longitudinal exterior dimension of his housing).

Claims 2-3 include the distinguishing limitations of claim 1.

Claim 4 recites an end piece. Bouchard teaches only a "lip 23" on each of his two tapes. These lips appear to simply be the bent-over distal ends of his tapes.

Claim 6 as amended recites that the end piece is rigidly coupled to the tape and that the second set of distance marks identify positions relative to the proximal face of the perpendicular portion of the end piece. Bouchard is silent as to whether his outside distance marks (those in full scale on the upper edge of the leftwardly projecting tape 21 in his Fig. 3) have had their position adjusted to account for the thickness of the bent-over lip. Indeed, the reasonable assumption would be that, since his bent-over lip is of the same thickness – to wit, very, very thin – as his tape, the marks would not need to compensate for this thickness, because the marks themselves are almost certainly thicker than the tape itself.

Claim 7 includes the distinguishing limitations of claims 1, 4, and 6.

Application No. 10/768,414  
Amendment dated 02/04/2005 responding to Office Action dated 11/04/2004

Claim 9 recites that "the distance indicators providing measurements from the distal end of the tape to the proximal edge of the housing". By way of contrast, Brouchard's inside measurement distance indicators (those in half-scale shown as 4, 5, and 6 in his Fig. 3) provide measurements from the distal end of one tape to the distal end of the other tape, not to the proximal edge of the housing.

Fig. 10 includes the distinguishing limitations of claim 9.

#### **Rejection over Bouchard and Usami**

Claim 5 was rejected under 35 USC 103(a) as unpatentable over Bouchard in view of US Patent No. 6,032,379 to Usami.

Claim 5 distinguishes over the combination of Bouchard and Usami by virtue of the elements of claim 1 which distinguish over Bouchard as indicated above.

#### **Rejection over Bouchard and Kuze**

Claim 8 was rejected under 35 USC 103(a) as unpatentable over Bouchard in view of US Patent No. 4,965,944 to Kuze et al.

Applicant cannot discern any relevant teaching in Kuze. Kuze teaches a tape measure with a single set of distance marks and distance indicators repeated on either edge of the tape (see his Fig. 4) so the user can read the "bottom" set of numbers "right-side-up" regardless of whether he is measuring from the left or from the right. The other markings, such as those shown in his Figs. 1 and 2, are angular markings, not distance markings, and they are on the housing, not on the tape.

Kuze's housing in his Fig. 3 is 3.5 inches long plus the thickness of the flat end plate 12, plus an unspecified distance to the right of the mark at the 3.5 inch position (two marks to the right of the point at which reference number 46's leader line touches the housing) to the end of the housing. Furthermore, note that in his Fig. 6, Kuze's housing appears to be roughly 3.25 inches plus those two deltas. The Kuze invention has absolutely nothing to do with inside measurements, much less to do with a tape having both inside and outside measurement marks specifically placed to compensate for an odd-sized housing. Applicant submits that the

Application No. 10/768,414  
Amendment dated 02/04/2005 responding to Office Action dated 11/04/2004

combination of Bouchard and Kuze does not teach the claimed elements. Applicant's own disclosure cannot be used as a guide for attempting to piece together a mosaic out of different pieces of prior art which do not, themselves, make any such suggestion.

**Rejection over Bouchard and Drechsler**

Claim 11 was rejected under 35 USC 103(a) as unpatentable over Bouchard in view of US Patent No. 4,574,486 to Drechsler.

Claim 11 specifically recites that "the inside measurement distance marks being offset along the tape from the outside measurement distance marks by a distance corresponding to a thickness of the perpendicular portion of the end piece". (emphasis added)

Drechsler teaches no such thing. Rather, what Drechsler teaches is that the "indicia 30A on the lower surface of the extended blade 26 ... are offset from the outer end of the blade 26 or hook 28 a distance Z ... which is equal to the length of the intermediate portion of the blade 26, i.e. the blade path inwardly of the casing 10 from the outer surface of the front wall 14 about the aperture 22 and to the indicator line 20 on the window 18 minus the length Y of the bottom wall". (col. 3 lines 48-54)

The Drechsler patent is assigned to The Stanley Works. Applicant's attorney has owned dozens of Stanley tape measures, and has never seen a single one of the handheld, self-retracting variety, in which the tape's end piece was rigidly coupled to the tape. Without exception, the Stanley tape end pieces are loosely, slidingly mounted with rivets through eccentric holes producing approximately as much "slop" as the thickness of the perpendicular portion of the end piece, specifically so that a single set of markings is accurate for both outside and inside measurements. Applicant has never seen one of Drechsler's "top-reading rules", and can only find a single reference to any "top-reading tape" on the internet, at

<http://www.powells.com/cgi-bin/biblio?show=HARDCOVER:USED:0671744429:19.95&page=excerpt>

which, perhaps not coincidentally, references a book called "The Stanley Complete Step-By-Step Book of Home Repair and Improvement" by James A. Hofnagel.

Application No. 10/768,414  
Amendment dated 02/04/2005 responding to Office Action dated 11/04/2004

**Rejection over Bouchard and Chilton**

Claim 12 was rejected under 35 USC 103(a) as unpatentable over Brouchard in view of US Patent No.6,684,522 to Chilton.

Chilton shows a tape having a single set of "distance indicators" (that is, numbers) and a single set of conventional "distance marks" (major and minor marking lines), as well as two sets of "spaced marks" (diamonds). The diamonds of one set are disposed at 14.5 inch intervals, and the diamonds of the other set are disposed at 22.5 inch intervals.

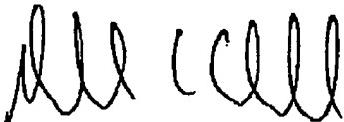
Chilton shows one or three sets of "distance marks", but only a single set of "distance indicators" (numbers).

Claim 12 recites "the distance indicators comprising outside measurement distance indicators and inside measurement distance indicators" and that "the outside distance indicators and the inside distance indicators are enabled to share the same set of distance marks". In other words, claim 12 recites a single set of lines and two sets of numbers, exactly the inverse of what Chilton teaches.

**CONCLUSION**

Applicant respectfully requests allowance of all claims, as they are neither anticipated nor made obvious by the references cited.

Respectfully submitted,



Richard C. Calderwood, Attorney for the Applicant  
Reg. No. 35,468  
phone (503) 313-4004

Date:

02-04-05